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| APPLICATION NO.                               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/909,673                                    | 07/20/2001  | Yoram Yaacovi        | MSFT-0314/164088.1  | 1516             |
| 41 505  | 7590        | 11/29/2005           | EXAMINER            |                  |
| WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) |             |                      | ELISCA, PIERRE E    |                  |
| ONE LIBERTY PLACE - 46TH FLOOR                |             |                      | ART UNIT            |                  |
| PHILADELPHIA, PA 19103                        |             |                      | PAPER NUMBER        |                  |

3621

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,673

Applicant(s)

YAACOV, YORAM

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This office action is in response to Applicant's response filed on 09/07/2005.
2. Claims 1-46 are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-46 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Stefik (U.S. pat. No. 5,715,403) in view of Reddy et al (U.S. Pat. No. 6,824,051).

As per claims 1, 6, 10-15, 20, 21, 25, 27-32, and 38-44 Stefik substantially discloses a system for ensuring that licenses are in place for using licensed products (which is readable as Applicant's claimed invention wherein said a method for providing to a first content package having a first license associated therewith), the method comprising: Receiving first data indicative of the first license, wherein the first license specifies one or more terms governing the relicensing of the content package (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55); and Licensing the first content package for use on the first computing device in accordance with said one or more terms (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44,

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lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid). Stefik further discloses the encryption keys (see., col 15, lines 24-54).

Stefik fails to explicitly disclose a payment is a condition for licensing content and revoked or made unusable as a condition for issuing a different license.

Reddy discloses a system/method for managing use of items having usage rights associated therewith. Conditions must be satisfied in order to exercise the manner of use in a specified usage right (or revoke as a condition for issuing a license). A clearinghouse 90 can be used to process payment transactions and verify payment prior to issuing a license (see., abstract, col 4, lines 25-42, col 5, lines 50-61). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Stefik by including the limitation detailed above as taught by Reddy because this would determine that the payment associated to the license is verified.

As per claims 2 and 3 Stefik discloses the claimed method of determining that licensure of the first content package for use on the first computing device is consistent with a first of said one or more terms (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid).

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As per claims 4, 5, 18, 19, 22, 23, and 26 Stefik discloses the claimed method wherein said terms requires collection of a payment as a condition of licensing the first content package for use on the first computing device, and wherein said action comprises collecting said payment (see., col 2, lines 21-44).

As per claim 7, 8, 9, 16, 17, 24, 33-37, and 45-46 Stefik discloses the claimed method wherein the content package comprises a content portion and the first license ( or repository, figs 1 and 2), and wherein said licensing act comprises:

Creating a second content package which comprises:

Said content portion (or repository); and

A second (or usage rights associated with repository 2) which permits access to said second content package on the first computing device (see., col 7, lines 16-48, figs 1 and 2); and transmitting said second content package to the first computing device (see., col 7, lines 16-48, figs 1 and 2, col 8, lines 1-32).

## RESPONSE TO ARGUMENTS

5. Applicant's arguments filed on 09/07/2005 have been fully considered but they are moot in view of new ground (s) of rejection.

## ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Elisca Pierre Eddy**

**Primary Patent Examiner**

**November 22, 2005**